

DOCKET NO.: 257242US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 1796

Thomas MARKERT, et al.

SERIAL NO: 10/507,203

EXAMINER: Hardee, John R.

FILED: January 24, 2005

FOR: USE OF UNSATURATED KETONES AS A FRAGRANCES

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Sir:

In response to the Restriction Requirement dated December 3, 2007, Applicants elect, with traverse, Group II, Claim 1, for examination. As a single disclosed specie, for examination purposes only, Applicants provisionally elect 1-(4-methyl-cyclohex-3-en-1-yl)-4-penten-1-one, the compound according to Claim 2.

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

Group I: Claim(s) 2-6, drawn to compounds and compositions containing same.

Group II: Claim(s) 1, drawn to use of chemical compounds.

Group III: Claim(s) 7, drawn to a method of producing chemical compounds.

In addition, an election of species is required as indicated:

Species Election : Election of one specific compound from the compounds of Claims 2-4.

Applicants elect, with traverse, Group II, Claim 1, for examination. As a single disclosed species, for examination purposes only, Applicants provisionally elect the compound according to Claim 2, (1-(4-methyl-cyclohex-3-en-1-yl)-4-penten-1-one).

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack a significant structural element qualifying as a special technical feature that defines a contribution over the prior art.

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. **The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).**”(Bold added)

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; . . .”

In addition, The MPEP §806.03 states:

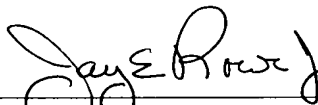
“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.”

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I-III with respect to 37 C.F.R. § 1.475(b)(3) and MPEP §806.03. Therefore the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention has not been met. For this reason, Applicants submit that the Requirement for Restriction should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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